

RECEIVED
CENTRAL FAX CENTER

NOV 20 2006

REMARKS

The Office Action dated June 19, 2006 has been reviewed and the comments of the U.S. Patent and Trademark Office have been considered. The following remarks are respectfully submitted to place the application in condition for allowance.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Claims 1-43 and 45-76 have been cancelled. Claim 44 has been amended. Support for amended claim 44 may be found, for example, in at least the following sections of the original disclosure: page 8, line 21; page 6, lines 15-18; page 16, lines 26-29; page, 15 lines 13-23; page, 20 lines 3-27. New claims 77-141 have been added. Support for new claims may be found, for example, in at least the following sections of the original disclosure:

- Claim 77-- page 7, lines 11-13.
- Claim 78-- page 18 lines 15-16.
- Claim 79-- page 18 lines 26-30.
- Claim 80-- page 18, lines 15-16.
- Claim 81-- page 18, lines 18-19.
- Claim 82-- page 18, lines 18- 19.
- Claim 83-- page 18, lines 18-20.
- Claim 84-- page 18, lines 21-24.
- Claim 85-- page 20, line 29 -- page 21, line 2.
- Claim 86-- page 21, lines 12-16; page 28, lines 12-15.
- Claim 87-- page 6, lines 15-18.
- Claim 88-- page 7, lines 24-25; page 8, line 3.
- Claim 89-- page 16, lines 29-30; page 19, line 30.
- Claim 90-- page 6, line 23.
- Claim 91-- page 7, line 17.

Claim 92-- page 7, line 18.
Claim 93-- page 7, line 18.
Claim 94-- page 7, line 18.
Claim 95-- page 7, line 18.
Claim 96-- page 7, line 19.
Claim 97-- page 7, line 19.
Claim 98-- page 7, line 16.
Claim 99-- page 26, lines 21-27.
Claim 100-- page 26, lines 25-27.
Claim 101-- page 15, line 30-page 16, line 8.
Claim 102-- page 15, lines 25-28.
Claim 103-- page 15, line 30-page 16, line 8.
Claim 104-- page 29, lines 19-21.
Claim 105-- page 29, lines 19-21.
Claim 106-- page 22, line 23.
Claim 107-- page 22, line 23.
Claim 108-- page 22, lines 23-24.
Claim 109-- page 22, line 25.
Claim 110-- page 19, line 19-20.
Claim 111-- page 23, lines 12-20.
Claim 112-- page 8, line 26-page 9, line 13.
Claim 113-- page 8, line 26-page 9, line 3.
Claim 114-- page 16, lines 26-29; page 19, lines 19-20.
Claim 115-- page 19, line 20.
Claim 116-- page 19, line 30.
Claim 117-- page 1, line 6.
Claim 118-- page 20, line 20.
Claim 119-- page 7, line 17.
Claim 120-- page 7, line 18.
Claim 121-- page 7, line 18.
Claim 122-- page 19, line 21.

Claim 123-- page 7, line 18.
Claim 124-- page 19, line 21.
Claim 125-- page 19, line 22.
Claim 126-- page 19, line 21.
Claim 127-- page 19, line 23.
Claim 128-- page 19, line 23.
Claim 129-- page 19, line 23.
Claim 130-- page 19, line 20.
Claim 131-- page 20, lines 9-13.
Claim 132-- page 30, lines 25-28.
Claim 133-- page 31, line 24 -- page 32, line 3.
Claim 134-- page 32, lines 5-7.
Claim 135-- page 32, lines 7-8.
Claim 136-- page 31, lines 14-19; page 32, lines 19-21.
Claim 137-- page 32, lines 10-11.
Claim 138-- page 34, lines 14-15.
Claim 139-- page 1, lines 4-6.
Claim 140-- page 6, line 19.
Claim 141-- page 6, line 20.

Priority

The Examiner contends that the parent applications contain no support for an RNA sequence limited to about 20-100 nucleotides in length. Therefore, the Examiner states that the present application is considered a continuation-in-part of the parent applications and the claims are afforded an effective filing date of April 8, 2004.

Applicants respectfully disagree. However, to further prosecution of this application, claims 1-43 and 45-76 have been cancelled. Claim 44 has been amended. Support for the amendments may be found in the priority document Australian Patent application no. PP2429 in

at least the following sections: page 4, line 2; page 7, line 15; page 8, line 26-page 9, line 3; page 15 lines 12-23; page 20 lines 3-27. The newly added claims are also fully supported in the priority documents. This application is therefore a continuation of the parent applications and should be afforded the effective filing date of March 20, 1998. Withdrawal of the rejection is respectfully requested.

Oath/Declaration

The Examiner indicated the oath/declaration is defective because the application was filed with a copy of the declaration executed in the parent application and therefore does not reflect the status of the application as a continuation-in-part. Applicants respectfully disagree with the objection. As discussed above, Applicants have cancelled the claims or amended portions of the claims which allegedly contain new matter. Amended claim 44 and newly added claims 77-141 are fully supported in the parent applications. The present application was properly identified as a continuing application. Applicants respectfully submit that the declaration executed in the parent and filed with the present application is in compliance with 37 CFR 1.67(a). Withdrawal of the objection is respectfully requested.

Rejections Under 35 U.S.C. §112

Claims 44, 47, 48 and 56-61 are rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. The Examiner states that there is no support in the priority documents, or the application as filed, for an upper limit of 100 bases for the length of the first RNA sequence.

Applicants respectfully disagree with the rejection. However, to expedite prosecution of the present application, claims 47, 48 and 56-61 have been cancelled, thus making the rejection with the respect to those claims moot. Independent claim 44 has been amended to delete the language objected to by the Examiner. The newly added limitations of "greater than 20 consecutive nucleotides", "stuffer fragment" and "eukaryotic cell" are fully supported in both the priority documents and the application as filed. New claims 77-141 are also fully supported in the parent applications. The claims are now compliant with the requirements of 35 U.S.C. §112, first paragraph. Withdrawal of the rejection is respectfully submitted.

Claims 44, 47, 48 and 56-61 are rejected under 35 U.S.C. §112, first paragraph as not being fully enabled. The Examiner states that the specification is enabling only for claims directed to isolated nucleic molecules complementary to a region on the target gene.

Applicants respectfully disagree with the Examiner's rejection. However, in the interest of advancing prosecution of this case, claims 47, 48 and 56-61 have been cancelled, thus making the rejection with the respect to those claims moot. Independent claim 44 has been amended to remove the objected recitation that "expression of the target gene is reduced by sequence-specific degradation of a RNA transcript of the target gene by an endogenous system of the mammalian cell". It is respectfully submitted that the subject matter of the amended claims is fully enabled in that all of the claimed molecules can be made and used in a eukaryotic cell. For example, each of the claimed molecules is functional in a cell such as a plant cell or an insect cell. Withdrawal of the rejection is respectfully submitted.

Rejections Under 35 U.S.C. §102

Claims 44, 47, 48 and 56-61 are rejected under 35 U.S.C. §102(a) as being anticipated by Harborth *et al.* (*Antisense Nucl. Acid Drug Dev.* 13:83-105 (2003); publicly available May 12, 2003).

In response, claims 47, 48 and 56-61 have been canceled, thus making the rejection with the respect to those claims moot. Amended claim 44 and newly added claims 77-141 are entitled to the priority date of the earliest filed parent application, *i.e.*, March 20, 1998. Harborth *et al.* is therefore not available as prior art under 35 U.S.C. §102(a) as it was published after the priority date of the present claims (as acknowledged by the Examiner on page 11 of the Office Action dated June 19, 2006). Withdrawal of the rejection is respectfully requested.

Claims 44, 47, 48 and 56-61 are rejected under 35 U.S.C. §102(b) as being anticipated by McManus *et al.* (*RNA* 8:842-850 (2002)).

In response, claims 47, 48 and 56-61 have been canceled, thus making the rejection with the respect to those claims moot. Amended claim 44 and newly added claims 77-141 are entitled to the priority date of the earliest filed parent application, *i.e.*, March 20, 1998. McManus *et al.* is therefore not available as prior art under 35 U.S.C. §102(b) as it was published after the priority date of the present claims. Applicants respectfully request withdrawal of the rejection.

Claims 44, 47, 48 and 56-61 are rejected under 35 U.S.C. §102(b) as being anticipated by Elbashir *et al.* (*Methods* 26:199-213 (2002)).

Applicants respectfully disagree with the rejection. Claims 47, 48 and 56-61 have been canceled, thus making the rejection with the respect to those claims moot. Amended claim 44 and newly added claims 77-141 are entitled to the priority date of the earliest filed parent application, *i.e.*, March 20, 1998. Elbashir *et al.* is therefore not available as prior art under 35

U.S.C. §102(b) as it was published after the priority date of the present claims. Withdrawal of the rejection is respectfully requested.

Claims 44, 47, 48 and 56-61 are rejected under 35 U.S.C. §102(b) as being anticipated by Argawal *et al.* (WO 94/01550). Applicants respectfully disagree with the rejection.

Argawal *et al.* teach anti-sense molecules stabilized with a self-complementary 3' region. Argawal *et al.* briefly contemplates that the self-complementary region may be connected to the anti-sense region by a "suitable *non-nucleic acid* linker" (emphasis added). See page 15, line 31-33. Examples of suitable non-nucleic acid linkers are given as substituted or unsubstituted alkyl groups and ethylene glycol. This is in contrast to Applicants' invention as illustrated in amended claim 44 and dependent claims. These claims recite a stuffer fragment which comprises a sequence of *nucleotides*. The linker as described in Argawal *et al.* is not the same structure as that described in Applicants' invention. Argawal *et al.* therefore does not teach nucleic acid molecules comprising each of the limitations of the instant claimed molecules. The present claims as amended are therefore not anticipated. Applicants respectfully request withdrawal of the rejection.

RECEIVED
CENTRAL FAX CENTER

NOV 20 2006

CONCLUSION

Applicants respectfully submit that the claims now stand ready and in condition for allowance. Based on the foregoing, further and favorable action on the merits is respectfully requested. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Applicants submit concurrently a request for extension of time under 37 C.F.R. 1.136 and the accompanying fee. In the event that any additional extensions of time are necessary to prevent the abandonment of this patent application, then such extension of time are hereby petitioned. The U.S. Patent and Trademark Office is hereby authorized to charge any fees that may be required in conjunction with this submission to Deposit Account Number 50-2228, referencing matter number 023004.0104N5US.

November 20, 2006

By: Kellie L. Carden
Kellie L. Carden
Registration No. 52,696

Patton Boggs, LLP
8484 Westpark Drive
9th Floor
McLean, Virginia 22102
(703) 744-7919 (direct)
(703) 744-8001 (facsimile)
kcarden@pattonboggs.com

3668086

19